



EXHIBIT 1

The opinion in support of the decision being entered today was not written for publication and is **not** precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JUL 17 2003

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BOYCE D. BURTS

Appeal No. 2003-0604
Application No. 09/307,544

HEARD: June 10, 2003

Before WALTZ, TIMM and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-13. Claims 14-33 have been cancelled. A copy of each of claims 1-13 is set forth in the attached appendix.

RECEIVED

OCT 15 2003

OFFICE OF PETITIONS

Claims 1, 2, and 7 stand rejected under 35 U.S.C. § 103 as being obvious over Sydansk in view of Githens.

Claims 1-4, and 7 stand rejected under 35 U.S.C. § 103 as being obvious over Merrill and Githens.

Claims 1, 2, and 5-13 stand rejected 35 U.S.C. § 103 as being unpatentable of House in view of Horner and Githens.

Claims 1-13 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of co-pending Application No. 09/296,217 in view of Sydansk, or over claims 1-10 of co-pending Application No. 09/296,216 in view of Sydansk.

The examiner relies upon the following references as evidence of unpatentability:

Horner et al. (Horner)	3,208,524	Sep. 28, 1965
Githens	4,566,979	Jan. 28, 1986
Sydansk	4,989,673	Feb. 05, 1991
House et al. (House)	5,004,553	Apr. 02, 1991
Merrill	5,377,760	Jan. 03, 1995
Claims 1-10 of Application No. 09/296,217,	filed April 22, 1999	
Claims 1-10 of Application No. 09/296,216,	Filed April 22, 1999	

OPINION

The common issue among all of the 35 U.S.C. § 103 rejections is whether the examiner has provided a proper factual foundation supporting her conclusion that one of ordinary skill in the art would have expected that the addition of inert solids (for example, sand), before activation with water, rather than after activation with water, would provide no substantial difference in results. (Answer, page 14.)

We note that the prior art can be modified or combined to reject claims as prima facie obvious as long as one of ordinary skill in the art would have had a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Here, the examiner's rejection lacks an explanation of how one of ordinary skill in the art would have had a reasonable expectation of success that no substantial difference in effect would occur if one of ordinary skill in the art would have added the sand in Sydansk prior to formation of the gel (i.e., prior to activation with an aqueous solvent) versus after formation of the gel. On page 14 of the Answer, the examiner states "the addition of inert solids, i.e. sand, would have no effect on the cross linking composition and gelling agent." Yet, the examiner does not provide facts on the record to support this as knowledge possessed at the time of invention by one of ordinary skill in the art. Due to this lack of factual foundation, we reverse each of the 35 U.S.C. § 103 rejections.

With regard to the provisional obviousness-type double patenting rejections of claims 1-13 over claims 1-10 of 09/296,217 and over claims 1-10 of co-pending application 09/296,216, in view of Sydansk, the examiner correctly indicates at the bottom of page 4 and the top of page 5 of the Answer, that appellant's brief does not contain an argument which specifies errors regarding these provisional rejections. Hence, we affirm each of these rejections.

Other Issues

Upon return of this application to the jurisdiction of the examiner, we ask the examiner to review the following patents regarding the issue of obvious-type double patenting, and to make of record that such review was conducted:

1. Burts, Jr., Published Jan. 25, 2000, 6,016,879;
2. Burts, Jr., Published Jan, 25, 2000, 6,016,871;
3. Burts, Jr., Published Aug. 8, 2000, 6,098,712; and
4. Burts, Jr., Published Aug. 15, 2000, 6,102,121.

CONCLUSION

Each of the 35 U.S.C. § 103 rejections is reversed.

Each of the provisional rejections under the judicially created doctrine of obviousness-type double patenting is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Thomas A. Waltz

THOMAS A. WALTZ
Administrative Patent Judge

)
)
)
)

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
)

Catherine Timm

CATHERINE TIMM
Administrative Patent Judge

)
)
)

Beverly A. Pawlikowski

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

)
)
)

BAP/sld

RECEIVED
OCT 15 2003
OFFICE OF PETITIONS

Appeal No. 2003-0634
Application No. 09/307,544

J.M (MARK) GILBRETH
GILBRETH & ASSOCIATES, P.C.
P.O. BOX 2428
BELLAIRE, TX 77402-2428

APPENDIX

1. A well plug additive comprising a dry mixture of a water soluble crosslinking polymer, a crosslinking agent, and a reinforcing material selected from among fibers and comminuted plant materials.
2. The additive of claim 1 wherein the polymer is an a carboxylate-containing polymer and the crosslinking agent is a chromic carboxylate complex.
3. The additive of claim 2 wherein the reinforcing material comprises hydrophilic and hydrophobic fibers.
4. The additive of claim 3 wherein the hydrophobic fibers comprise at least one selected from the group of hydrophobic fibers consisting essentially of nylon, rayon, and hydrocarbon fibers, and wherein the hydrophilic fibers comprise at least one selected from the group of hydrophilic fibers consisting essentially of glass, cellulose, carbon, silicon, graphite, calcined petroleum coke, and cotton fibers.
5. The additive of claim 2 wherein the reinforcing material comprises comminuted plant material.
6. The additive of claim 5 wherein the reinforcing material comprises at least one comminuted material selected from the group of comminuted plant materials consisting essentially of nut and seed shells or hulls of almond, brazil, cocoa bean, coconut, cotton, flax, grass, linseed, maize, millet, oat, leachy, peanut, rice, rye, soybean, sunflower, walnut, and wheat; rice tips; rice straw, rice bran; crude pectate pulp; peat moss fibers; flax; cotton; cotton linters; wool; sugar cane; paper; bagasse; bamboo; corn stalks; sawdust; wood; bark; straw; cork; dehydrated vegetable matter; whole ground corn cobs; corn cob light density pith core; corn cob ground woody ring portion; corn cob chaff portion; cotton seed stems; flax stems; wheat stems; sunflower seed stems; soybean stems; maize stems; rye grass stems; millet stems; and mixtures thereof.
7. The additive of claim 2 wherein the polymer is a partially hydrolyzed polyacrylamide.

8. The additive of claim 7 wherein the reinforcing material is a comminuted material selected from among comminuted materials derived from peanuts, wood, paper any portion of rice seed or plant, any portion of corn cobs, and mixtures thereof.

9. The additive of claim 8 wherein the additive further includes cellophane, and wherein the reinforcing material is a comminuted material selected from among mixtures of comminuted rice fraction and peanut hulls; mixtures of comminuted rice fraction, and wood fiber or almond hulls; mixtures of comminuted rice fraction and corn cob fraction; and mixtures of comminuted rice fraction and corn cob fraction and at least one of wood fiber, nut shells, and paper.

10. The additive of claim 9 wherein the reinforcing material comprises comminuted mixture of rice fraction, corn cob pith and chaff, cedar fiber, nut shells, and paper.

11. A method of forming a well plug fluid comprising:

(a) providing a well plug additive comprising a dry mixture of water soluble crosslinking polymer, a crosslinking agent, and a reinforcing material selected from among fibers and comminuted plant materials; and

(b) contacting the well plug additive with water or an aqueous solution to form the well plug fluid.

12. The method of claim 11 wherein the polymer is a partially hydrolyzed polyacrylamide, the crosslinking agent is a chromic carboxylate complex, wherein the additive further includes cellophane, and wherein the reinforcing material is a comminuted material selected from among mixtures of comminuted rice fraction and peanut hulls; mixtures of comminuted rice fraction, and wood fiber or almond hulls; mixtures of comminuted rice fraction and corn cob fraction and at least one of wood fiber, nut shells, and paper.

13. The additive of claim 12 wherein the reinforcing material comprises comminuted mixture of rice fraction, corn cob pith and chaff, cedar fiber, nut shells, and paper.